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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,227	11/27/2001	Zhiping Shan	1094-14	1449

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EXAMINER	
MEDINA SANABRIA, MARIBEL	
ART UNIT	PAPER NUMBER
1754	

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/995,227

Applicant(s)

SHAN ET AL.

Examiner

Maribel Medina

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 11-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 11-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

#### **Election/Restrictions**

1. Claims 11-31 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 8 filed on 8/27/03.

Applicant's election with traverse of Group I, claims 1-10, in Paper No. 8 filed on 8/27/03 is acknowledged. Applicants argue: *the "claims 11-25 of group II should be examined on the merits concurrently with claims 1-10 of Group I" "The claims are classified in the same class and subclass. A proper search for the Group I claims would necessarily include the Group II claims."* This argument is not persuasive, since although the Groups are classified in the same class and subclass, the Restriction Requirement is still proper, since the product as instantly claimed can be made by a different process of that of Group II as evidenced by WO 97/20016 (see rejection below).

Applicants argument in regards to the use of water as solvent or liquid is moot in, in view of the grounds for restrictions presented above. The product as instantly claimed can be made by a different process of that of Group II as evidenced by WO 97/20016 (see rejection below).

The requirement is still deemed proper and is therefore made FINAL.

#### **Information Disclosure Statement**

2. The reference US Patent No 5,191,134 in the information disclosure statement filed 5/12/03 was not signed, since it was considered in the IDS filed on 2/26/2002.

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**Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/20016 as evidenced by US Patent No. 6,346,140.

In regards to the limitations of claims 1, 2, 3, 4, 6 and 7, WO 97/20016 disclose a material which comprises beta zeolite (See page 7, lines 21-23) and a porous inorganic oxide such as a crystalline mesoporous aluminosilicate of structures MCM-41, MCM-48 and FSM-16.

WO 97/20016 discloses the instantly claimed material but is silent in regards to the volume percentage of mesopores in the inorganic oxide.

US Patent No. 6,346,140 is relied as evidence to show that FSM-16 is a mesoporous material of at least 97 volume percent mesopores (See col. 19, line 12 to col. 20 line 10). Specifically in Table 4, sample c (which is FSM-16) it is disclosed that FSM-16 has 0 micropores volume (cc/g) this clearly is 0 volume % micropores and 100 volume percent mesopores.

In regards to the limitation of claim 5, US Patent No. 6,346,140 further disclose a FSM-16 with pore size of 2.57 nm (See Table 4, sample c).

Note that the secondary reference (US Patent No. 6,346,140) is only provided as evidence. "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such

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evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." (See *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991).

In regards to claim 8, WO 97/20016 discloses, the addition of a metal such as cobalt or nickel (See page 9, lines 23-35).

In regards to claims 9 and 10, WO 97/20016 discloses, the zeolite in amounts ranging from 0.5 to 40 wt. % (See page 10, lines 19-26).


No difference is seen between the instantly claimed invention and WO 97/20016.

**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maribel Medina whose telephone number is (703) 305-1928. The examiner can normally be reached on Monday through Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (703) 308-3837. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Maribel Medina  
Examiner  
Art Unit 1754